

10/694,852

Art Unit: 3727

Response to office action mailed 12/16/2004

Remarks

The applicants have attended to the objection to the abstract. While the Examiner purported to reject claim 15 under 35 USC 112, it is believed from the accompanying language that the Examiner was actually referring to claim 16. Claim 16 has thus been amended accordingly on this assumption.

Claim 1 has been amended to make it clear that the condiment opening is separate from and larger than the drink opening.

The Examiner rejected claim 1 as being unpatentable over Warden in view of Hundley under 35 USC 103. It is noted that in order to sustain a valid rejection, the Examiner must show all the limitations of the claim in the cited references, either inherently or expressly, and must also show a valid motivation to combine the references in order to arrive at the invention claimed.

Claim 1 has been amended to specify that the condiment opening is larger than the drink access port and also recite the fact that the first region, which defines the opening plus the tab in the fold back position, extends across at least about half of the cover 20. While formal support for this statement has been added in paragraph [0031], it does not constitute new subject matter because it is merely a statement of what is clearly shown in the various embodiments, namely in Figure 5 where the first region extends over about half the cover and in the other embodiments where it extends over slightly more than half the cover.

The Examiner's primary reference is Warden. As described the opening 34 is not a drink opening, but rather a vent hole to allow the user to draw fluid through the drink opening made by tab 30. It is agreed that the Examiner is entitled to consider the vent hole a drink opening if it can be shown that it *could* be used for this purpose. Warden however clearly does not show two holes meeting the limitations of amended claim 1 even if used in a way different from the way proposed by Warden.

The reason for the size limitation introduced into claim 1 is that the condiment opening must be large enough to allow the user to add sugar, milk and the like, which requires a reasonably sized opening. The opening defined by the tab 30 in Warden, which is intended as drink opening, clearly would not be suitable for this purpose, even if Warden were used in a way not intended, namely by drinking through the vent hole 34.

10/694,852

Art Unit: 3727

Response to office action mailed 12/16/2004

When combining references, it is not permissible to modify a reference in a way that results in the reference not being suitable for its intended purpose. Clearly, in accordance with the teachings of Warden there would be no motivation to enlarge the vent hole 34 since a vent hole only needs to be of sufficient size to permit air to enter the cup.

Moreover, there would be no motivation to enlarge the opening defined by the tab 30 since this is described as a drink opening, and clearly as a drink opening it is of sufficient size. Any enlargement of the drink opening would increase the risk of spillage. In addition, there would be no motivation to place the drink opening within an inner portion the cover because to be accessible as a drink opening, which is the purpose taught by Warden, it needs to be near the periphery of the cover.

The prior art clearly does not show, neither alone nor in combination, a cup lid with a drink opening and a condiment opening as claimed. The references were pertinent to the extent that even though they did not disclose both a drink opening and a condiment opening, Warden contained two openings, which arguably could have been used for these purposes, albeit inefficiently (The opening 30 would not have made a very satisfactory condiment opening because it is too small). Consequently, without inherently making use of the teachings of the present invention, a person skilled in the art would not be motivated to modify the references to arrive at the invention now claimed.

Accordingly, it is respectfully submitted that claim 1, and the claims dependent thereon, are patentable over the prior art.

Reconsideration and allowance are therefore respectfully requested.

Respectfully submitted,



Richard J. Mitchell
Registration No. 34519
Agent of Record

MARKS & CLERK
P. O. Box 957, Station B,
Ottawa, Ontario, Canada
K1P 5S7
(613) 236-9561